

REMARKS

In an Office Action mailed on June 27, 2005, objections were made to claims 10 and 19; claims 1-15 were rejected under 35 U.S.C. § 101; claims 1, 3, 4, 12 and 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by House; claims 2, 5-11 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Joseph; and claims 15-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Official Notice. Claims 10 and 19 have been amended to overcome the corresponding objections. The §§ 101, 102 and 103 rejections are addressed below.

§ 101 Rejections:

As amended, the method of independent claim 1 recites providing an online catalog on a computer. The catalog has an unavailable product/attribute selector.

Applicant first points out that claim 1 is not directed to an abstract or mathematical algorithm, as contended by the Examiner, in that claim 1 is directed to, among other things, providing an online catalog, a tangible and useful result. The Examiner contends, "providing an online catalog,' as such, is held to be a merely trivial application of technology." Office Action, 3. However, Applicant submits this is not the proper standard for determining whether a process complies with Section 101. For at least the reason that the Office Action fails to set forth a proper basis for why the subject matter of claim 1 does not comply with § 101, claims 1-15 overcome the § 101 rejections. Additionally, for purposes of expediting prosecution, line 2 of claim 1 has been amended to recite that the online catalog is provided on a computer. Therefore, for at least this additional, independent reason, claims 1-15 overcome the § 101 rejections.

§§ 102 and 103 Rejections of Claims 1-15:

The method of independent claim 1 is for providing custom-engineered products. As amended, the method includes providing an online catalog on a computer. Claim 1 has also been amended to clarify what is meant by "unavailable." In this regard, as amended, claim 1 recites that the online catalog has an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale. The method includes receiving a selection of an unavailable product/attribute that requires one or more of engineering and testing before it may be produced. A potential advantage of the method of independent claim 1 is that a seller may be able to extend its line offering based upon actual market demand (due to the selection of

unavailable products), as opposed to simply developing a new product in the hope that a sufficient market exists for the product. Specification, 7. Of course, other and different advantages are possible in other embodiments of the invention.

Contrary to the limitations of independent claim 1, House describes a network that provides selectable configuration options for a test, measurement and automation (TMA) environment. House describes that some of these components are "off-the-shelf" components; and House describes that some of the components may be custom-built components, such as specific electronic circuits, printed circuit boards, custom software development, etc. *See, for example*, House, 4:59-67 and 5:1-3.

House does not, however, teach or suggest that any of the products that are selected via its network build-to-order system are not offered for sale. Thus, House's products, whether custom built or off-the-shelf components, are all available. Therefore, House does not teach or even suggest providing an online catalog that has an unavailable product/attribute selector as specifically recited in amended independent claim 1; and thus, House fails to anticipate this claim.

Claims 2-15 are patentable for at least the reason that these claims depend from an allowable claim. Applicant also requests the Examiner to independently consider the patentability of the dependent claims. For example, in rejecting claim 9, the Examiner states that claim 9 is unpatentable over House in view of Official Notice. In particular, the Examiner states that Official Notice is taken that is well known to provide lists of available products in online catalogs. Office Action, 8. While in the abstract this may be true, the limitations of claim 9 must be considered in their entirety. In other words, claim 9 in combination with claim 1 from which it depends recites that a list of available products in an online catalog is provided in conjunction with an unavailable product/attribute selector. Thus, as contended above, House only provides a list of available products. There is, however, no teaching or suggestion in House regarding the combination of an available product list and the unavailable product/attribute selector that is set forth in claim 9. Applicant challenges the Official Notice to the extent that the Examiner takes Official Notice to the suggestion or motivation to modify House so that House's system includes the missing claim limitations, namely, an online catalog that includes an unavailable product/attribute selector.

Rejections of Claims 15-33:

As amended, the method of independent claim 15 includes displaying a list of available products that can be ordered from a provider and providing an unavailable product/attribute selector in the computer system to select one of a product and an attribute that cannot be ordered from the provider.

See discussion of independent claim 1 above. In particular, House fails to teach or suggest providing an unavailable product/attribute selector as now recited in claim 15 and for at least this reason, the hypothetical combination of House and the facts taken in the Official Notice fail to establish a *prima facie* case of obviousness for claim 15. To the extent that the Official Notice is being used to supplement House's disclosure so that House's system provides an unavailable product/attribute selector to select one of a product and an attribute that cannot be ordered from a provider, Applicant challenges the Official Notice and requests the Examiner to provide a reference with this teaching.

Claims 16-33 are patentable for at least the reason that these claims depend from an allowable claim.

§ 103 Rejections of Claims 34-36:

As amended, the method of independent claim 34 includes providing a set of available product data records in a memory. Each available product data record contains a specification for an associated available product. The method of independent claim 34 also includes providing a set of unavailable product data records in the memory. Each unavailable product data record contains a specification for an associated unavailable product. The method includes displaying the set of available product data records and the set of unavailable product data records on a visual display. Claim 34 recites that each of the unavailable products cannot be ordered from a seller.

Contrary to the limitations of independent claim 37, House fails to teach or even suggest providing a set of unavailable product data records in the memory, where each unavailable product cannot be ordered from a seller. See discussion of independent claim 1 above. The Examiner takes Official Notice that it is allegedly well known to have products already assembled and available. However, to the extent the Examiner takes Official Notice to the act of providing the set of unavailable product data records in the memory as now recited in claim 34

or the suggestion or motivation to modify House to derive the missing claim limitations, Applicant hereby challenges the Official Notice and requests a reference from the Examiner to supply the missing claim limitations and/or suggestion or motivation.

Claims 35 and 36 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103(a) rejections of claims 34-36 is requested.

§ 103 Rejection of Claim 37:

The method of independent claim 37 includes receiving into a processor in an input, via a user interface selection device, of a specification for an unavailable product that cannot be ordered from a seller. The method includes executing a resource costing module in the processor to determine the resource caused for creating the unavailable product. A price is transmitted from the processor via the electronic transmission based upon the resource cost.

Contrary to the limitations of independent claim 37, House fails to teach or suggest providing a specification for an unavailable product that cannot be ordered from a seller, and thus, for at least this reason, fails to teach or suggest the acts of receiving, executing and transmitting of claim 37. See discussion of claim 1 above. The Examiner takes Official Notice that electronic transmission over the Internet or an intranet is an electronic transmission. To the extent, however, that the Examiner takes Official Notice to the missing claim limitations that are set forth above and/or the suggestion or motivation to modify House to derive the missing claim limitations, Applicant hereby challenges the Official Notice and requests the Examiner to provide a reference with the requisite teachings.

Thus, withdrawal of the § 103 rejection of claim 37 is requested.

§ 103(a) Rejection of Claim 38:

The method of independent claim 38 includes providing a set of available product data records in a memory. Each available product data record contains a specification for an associated available product. The method includes providing a set of variance data records in the memory. Each variance data record contains an allowed variance to an associated available product. The method includes displaying the set of available product data records and the set of

variance data records on a visual display and receiving an input, via a user interface selection device, of a user selection from the set of variance data records.

Contrary to the limitations of independent claim 38, House fails to teach or suggest providing a set of variance data records, with each data variance record containing an allowed variance to an associated available product. The Examiner cites language from columns 9 and 13. However, Applicant requests the Examiner to specifically identify which language allegedly teaches the variance records and the corresponding providing of the set of variance records and the displaying of the set of variance records. Otherwise, a *prima facie* case of obviousness has not been established for claim 38 for at least the reason that the hypothetical combination of House and the facts taken in the Official Notice fail to teach or suggest all claim limitations. To the extent that the Examiner is relying on the Official Notice to supply the missing claim limitations or a suggestion or motivation to modify House to derive the missing claim limitations, Applicant hereby challenges the Official Notice and requests a reference to support the teaching.

§ 103 Rejections of Claims 39-41:

The memory structure of independent claim 39 includes a read/write memory device that is coupled to a computer system that provides the memory structure. The memory structure includes an available product list that is implemented in the read/write memory and an unavailable product/attribute selector that is implemented in the read/write memory allowing selection of products/attributes that cannot be ordered from a given provider.

Contrary to the limitations of independent claim 39, House fails to teach or suggest the unavailable product/attribute selector. *See, for example*, discussion of independent claim 1 above. Therefore, for at least the reason the hypothetical combination of House and the Official Notice fails to teach or suggest all claim limitations, a *prima facie* case of obviousness has not been established for independent claim 39. To the extent that the Official Notice supplies the missing claim limitations and/or the alleged suggestion or motivation to modify House to derive the missing claim limitations, then Applicant challenges the Official Notice and requests a reference to supply the teaching.

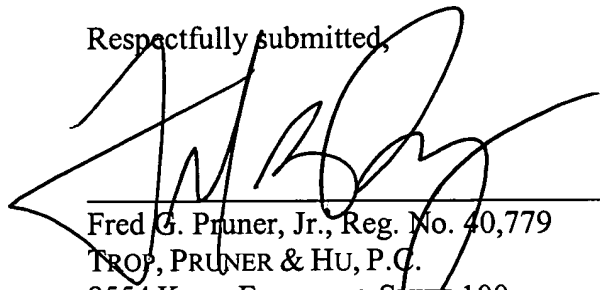
Claims 40 and 41 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the § 103(a) rejections of claims 39-41 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 101, 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,

Date: October 4, 2005



Fred G. Pruner, Jr., Reg. No. 40,779
TROP, PRUNER & HU, P.C.
8554 KATY FREEWAY, SUITE 100
HOUSTON, TEXAS 77024
713/468-8880 [Phone]
713/468-8883 [Fax]